



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Am

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,641	06/27/2001	Kenneth H. Abbott	294438020US2	1956

500 7590 06/15/2005

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 6300
SEATTLE, WA 98104-7092

EXAMINER

HAILU, TADESSE

ART UNIT	PAPER NUMBER
----------	--------------

2173

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,641

Applicant(s)

ABBOTT ET AL.

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-53, 55, 57-62 and 66-143 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51-53, 55, 57-62, 66-74, 76-129 and 132-143 is/are allowed.
- 6) ☒ Claim(s) 75, 130 and 131 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/28/05</u> | 6) <input type="checkbox"/> Other: _____ |

RD

DETAILED ACTION

1. This Office Action is in response to the Amendment entered on March 28, 2005 for the US Patent Application number 09/894,641 filed June 27, 2001.

Priority

2. The current application claims priority from US Pat Application 09/216,193 filed December 18, 1998, now patented, 6,466,232.

Information Disclosure Statement

3. The Information Disclosure Statements submitted on 3/28/05 is considered and entered into the file.

Status of the claims

4. The pending claims 51-53, 55, 57-62, and 66-143 are examined herein as follow.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 75, 130, and 131 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regard to claim 75, the preamble recites "a portable computer" which is hardware, and the remainder of the claim recites "an attribute mapping module" and "an information supplier module" which are not necessary hardware

components. To begin with, the recited modules are not positively recited, that is, they are just “capable of receiving...” secondly, since the preamble recites a hardware, “portable computer” then at least one element or feature of said “portable computer” should have been recited in the body of the claim. In sum, the claim is at best directed to an arrangement of software “modules”, *per se*, and is non-statutory, thus, the claim is rejected under **35 USC § 101** as not being tangible.

With regard to claim 130, the preamble recites “a computing device” which is not necessarily hardware, and the remainder of the claim recites “an input module” and “a resource access module”, which are software modules. To begin with, the recited modules are not positively recited, that is, they are just “capable of receiving...” secondly, if the preamble is directed to a hardware, “a computing device” then at least one element or feature of said “a computing device” should have been recited in the body of the claim. In sum, the claim is at best directed to an arrangement of software “modules”, *per se*, and is non-statutory, thus, the claim is rejected under **35 USC § 101** as not being tangible.

With regard to claim 131, the preamble recites “a computing device”, and the body of the claim recites means plus function languages including “means for receiving indications”, “means for determining a need for access”. For the above means plus function language equivalents, the specification describes software modules or components. Since the specification does not necessarily provide the equivalent hardware for the claimed means plus function languages of the alleged

“computing device”, the claim is non-statutory and is rejected under *35 USC § 101* as not being tangible.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 130 and 131 are rejected under 35 U.S.C. 102(b) as being anticipated by Theimer et al (US Pat No 5,611,050).

With regard to claim 130:

Theimer discloses a method in a first computer for providing information (e.g. portable device 64, Fig. 2) about a current state that is represented with multiple attributes (such as location information gained from badge serve, Input Monitor, etc).

Theimer further discloses “an input module” capable of receiving indications of multiple characterization modules (e.g., DeviceAgent and TerminalAgents , Fig. 2) that each model a current state related to a computer (portable computer 64 and terminal 66) on which that characterization module executes, each modeled current

state represented with at least one attribute (column 14, lines 1-column 15, lines 32).

Theimer further discloses "a resource access module" capable of determining a need for access to a resource accessible to one of the computers on which one of the characterization modules is executing; and using the one characterization module to access the resource (as illustrated in Fig. 2, each device agent has access to other device agent, this interaction between agents enables them to access and share resources (column 14, lines 1-column 15, lines 32).

With regard to claim 131:

Independent claim 131 is a computing device claim corresponding to claim 130, claim 131 directed to means plus function claim format, and is believed to be unpatentable for at least the same reasons as described above in connection with claim 130.

Allowable Subject Matter

7. Claims 51-53, 55, 57-62, 66-74, 76-129, 132-143 are allowed.

8. Claim 75 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

Conclusion

9. Regarding this Application, the Examiner notified the Applicant on May, 13, 2005 (via telephone) that claims 130 and 131 are not directed to a statutory subject matter, the Applicant prepared proposed amendment for claims 130 and 131

Art Unit: 2173

accordingly, but the proposed amendment was not formally and timely filed. As a result, the Examiner has prepared this Office Action.

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 273-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 273-4048 Art Unit 2173.

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Patent Examiner
Tadesse Hailu
Art Unit 2173
6/9/05

